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DILLON & YUDELL LLP 8911 N. CAPITAL OF TEXAS HWY., SUITE 2110 AUSTIN, TX 78759			AMINI, JAVID A	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RABINDRANATH DUTTA

Appeal 2009-003738
Application 09/583,346
Technology Center 2600

Decided: August 31, 2009

Before MAHSHID D. SAADAT, CARL W. WHITEHEAD, JR.,
and BRADLEY W. BAUMEISTER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 2-8, 11, 12, 14-17, 20, 21, 23-26, and 28-30. Claims 1, 9, 10, 13, 18, 19, 22, and 27 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellant's invention relates to a method for displaying data on a handheld device such that the displayed data is flipped between different orientations in order to effectively display the data. (Spec. 3.)

Claim 28 is illustrative of the claimed invention and reads as follows:

28. A method for displaying data on a portable device having a display that is significantly larger in a first dimension than in a second dimension, said method comprising the steps of:
 receiving a data page in the portable device;
 analyzing the data page; and
 automatically displaying the data page in either a first orientation or a second orientation within the display in response to the analysis of the data page.

The prior art applied in rejecting the claims on appeal is:

Moriya	US 6,161,140	Dec. 12, 2000
		(filed Sep. 30, 1997)

Claims 2-8, 11, 12, 14-17, 20, 21, 23-26, and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriya.¹

We refer to the Appeal Brief (filed Jan. 16, 2008 and supplemented Feb. 29, May 28, and Aug. 7, 2008) and the Answer (mailed Sep. 3, 2008) for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which

¹ The discussion of the claim rejection is repeated on pages 3-9 of the Examiner's Answer.

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Appellant did not make in the Brief have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Appellant's arguments are limited to claim 28 (Br. 4-5) and assert patentability of the remaining claims based on these arguments (Br. 5). Therefore we select claim 28 as representative of the claims on appeal. *See* 37 C.F.R. § 41.37(c)(1)(vii).

In rejecting claim 28, the Examiner relies on code transfer section 12 in Figure 15 of Moriya for “automatically prepar[ing] the model code” (Ans. 3). The Examiner asserts that the model code includes the display capabilities which are decoded in the central facility 2A, analyzed and modified by the code discrimination section 22 and code setting section 24 in figure 1, and used for transferring the data to the data terminal for display (Ans. 3-5). Appellant argues that the code transfer section 12 is not involved in display of data page within the data terminal nor facilitates analyzing the data page and automatically displaying the data page (Br. 4-5). Thus, the arguments made by Appellant present us with the following issue:

Has Appellant shown that the Examiner erred in rejecting claim 28 under 35 U.S.C. § 103(a) by modifying Moriya to specifically teach the claimed step of analyzing the data page and automatically displaying the data page in one of the two orientations?

PRINCIPLES OF LAW

Office personnel must rely on Appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). “[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). “On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness . . .” *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-88; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

Such a showing requires ‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the

analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. at 418 (quoting *In re Kahn*, 441 F.3d at 988).

ANALYSIS

Appellant refers to the description of Figure 15 of Moriya in column 9, lines 6-22 and argues that the code transfer section 12 is not involved in the display of data and only transfers data from the data terminal to the central facility 2A (Br. 4). Appellant further contends that the above noted section of Moriya indicates that the code transfer section 12 cannot automatically display the data page because it transfers a model code based on capabilities of the terminal that are inputted by the user (Br. 5).

The Examiner responds that the claimed steps of analyzing the data page and automatically displaying the data page within the portable device display are not required to take place necessarily in the portable device (Ans. 10-11). By relying on Figures 1 and 15 of Moriya, the Examiner asserts that the data modification section 232 automatically modifies the data to be displayed in the portable data terminal in response to the analysis performed by the code discrimination section 22 and the code setting section 24 (Ans. 11).

We agree with the Examiner's line of reasoning and find that the only step required to occur within the portable device in claim 28 is the step of receiving a data page. As argued by the Examiner (Ans. 10-11), the claim does not preclude the central facility performing the steps of analyzing the data page and automatically displaying the data page.

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Therefore, we disagree with Appellant's argument (Br. 5) that because the code transfer section does not facilitate the display the data page, the claimed steps of analyzing the data page and automatically displaying the data page are not suggested by Moriya. As such, we find that Appellant has not overcome the *prima facie* case of obviousness set forth by the Examiner and supported by "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," as required by the holding in *In re Kahn*.

CONCLUSION

In view of our analysis above, we agree with the Examiner's determination of the scope of claim 28 and find that the teachings of the applied prior art, when considered as a whole, support the Examiner's obviousness rejection by teaching the claimed steps of analyzing the data page and automatically displaying the data page. Thus, since Appellant has not shown error in the Examiner's position, we sustain the 35 U.S.C. § 103(a) rejection of all the claims over Moriya.

ORDER

The decision of the Examiner to reject claims 2-8, 11, 12, 14-17, 20, 21, 23-26, and 28-30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. 1.136(a)(1)(iv).

AFFIRMED ✓

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